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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,792	09/01/2005	Edward J Sare	07811.0019-00	8239
22852	7590	05/04/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER PARVINI, PEGAH	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 05/04/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,792

Applicant(s)

SARE ET AL.

Examiner

PEGAH PARVINI

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-34 and 37-39 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The action is being made non-final as per applicants request, because after further review, the examiner inadvertently did not fully address applicants statement of criticality in the specification, as argued.

Applicant is advised that should claim 26 be found allowable, claim 39 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

The rejection of claims 1-4, 6, 13-18, 26-27, 29-30, 34, 37 and 39 under 103(a) are being unpatentable over Cecil as generally set forth in the previous Office action is proper and stands.

The rejection of claims 23-25 and 33 under 103(a) over Cecil in view of Mohler as generally set forth in the previous Office action is proper and stands.

The rejection of claim 28 under 103(a) over Cecil in view of Joseph et al. as generally set forth in the previous Office action is proper and stands.

The rejection of claims 7-8 and 10-12 under 103(a) over Cecil in view of Corbett et al. as generally set forth in the previous Office action is proper and stands.

The rejection of claims 7-10, 31-32 and 38 under 103(a) over Cecil in view of Grinnell and further in view of Portnoy et al. as generally set forth in the previous Office action is proper and stands.

The rejection of claims 19-22 under 103(a) over Cecil in view of Malhotra et al. as evidenced by Colton et al. and/or evidenced by Lindemann et al. as generally set forth in the previous Office action is proper and stands.

Response to Arguments

Applicants' arguments filed January 29, 2009 with respect to the prior art, specially, Cecil disclosing the use of ball milling (i.e. mechanical milling) have been fully considered, and found persuasive; thus, the rejection over claims 35-36 and 39 as generally set forth in the previous Office action is hereby withdrawn.

With reference to Applicants' argument regarding the rejection of claim 39 as being a substantial duplicate of claim 26, it is to be noted that the proper form paragraph as set forth above has been used to address the objection made to claim 39.

Applicants' arguments filed January 29, 2009 have been fully considered but they are not persuasive.

Applicants have argued that they have presented evidence in the specification showing the criticality of their invention and have argued that these evidences have not been considered.

The Examiner, respectfully, submits that since the data shown in "Table X" (i.e. pages 18-19, paragraph [063]), shows only a higher gloss at 60° and a higher sheen, but in fact shows a lower brightness as evidenced by tables in the specification, therefore, Applicants have not shown any evidence showing the criticality of their inventions. Although a *prima facie* obviousness based on overlapping ranges may be overcome by showing criticality of the claimed ranges, Applicants have failed to do so based on the above and as follows below. Furthermore, Applicants have pointed to page 3 and page 15 of the specification; it is to be noted that page 3 only states that instant invention is an unexpected discovery and details out certain limitation of claim 1; however, does not submit any critical data and does not show any unexpected result. Page 15, paragraph [061] (i.e. Table III), also, does not compare the stability with that of the prior art. In addition, the scope of the data is not commensurate in scope with the claimed invention because (1) the data presented is for specific size values and are

much more narrower when compared to what is claimed and (2) the data referred to in section [0063] is for a paint formulation, however, Applicants are merely claiming a composition and Applicants have not shown that the same results will be apparent for any and all composition containing the calcined kaolin as defined in the instant claims. In as much as claim 37 is directed to a paint, the data in the specification is directed to a specific paint formula, the ingredients which are not defined in claim 37.

Considering the fact that Applicants had not submitted and have not yet submitted any other tangible evidence, and considering the fact that Cecil as detailed out in the previous Office action makes the instant invention obvious either alone (for certain claims) or in combination (for other claims), Cecil is seen to read on the claims of instant invention and absence showing any criticality, the rejection as set forth in the previously is proper and stands.

Furthermore, Applicants have not presented any tangible evidence comparing characteristics of the prior art of record, with the instantly claimed invention to prove the unexpected results which would possibly, if any, not seen for the prior art compositions.

In response to applicants' arguments against the references individually such as Mohler, Joseph et al., Corbett et al., Grinnell, Portnoy et al., Malhotra et al., Colton, and Lindemann, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is to be noted that instant claims 7-10, 12, 19-24, 28, 31-33, 38 have been rejected under 103(a) obviousness over a combination of references as detailed out in the previous Office action and applicants need to compare the claimed invention to that of the reference applied.

Allowable Subject Matter

Claim 36 is allowed.

The following is an examiner's statement of reasons for allowance: the prior art disclose ball milling (i.e. mechanical milling) the slurry which comprises calcined kaolin; however, the prior art do not suggest or disclose not mechanical milling the slurry.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim 35 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 36. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGAH PARVINI whose telephone number is (571)272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegah Parvini/
Examiner, Art Unit 1793

/Michael A Marcheschi/
Primary Examiner, Art Unit 1793